

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

According to the Examiner, the priority claim is denied because there is no certified translation of the priority document in the file. In response, Applicants point out that the certified copy of the priority document was filed on September 24, 2003; and the certified translation of the priority document was filed on March 24, 2006; and, moreover, the certified translation can be accessed on PAIR. (The translation is entered in PAIR on March 24, 2006, as “Certified Copy of Foreign Priority Application.” In short, the certified translation was filed and the priority claim should not have been denied.

Claims 10-16 and 19-24 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the term “reducing” in part (a) of claim 10 has no antecedent basis in the specification and, therefore, its use in the claims constitutes new matter. Applicants respectfully disagree.

In this regard, Applicants call the Examiner’s attention to the titles of the various examples on pages 21-24 expressly stating “reduction,” i.e., “reducing,” of keto compounds to the corresponding hydroxyl compounds.

Step (a) of claim 10 involves conversion of just such a keto compound of the formula (I):



to the corresponding hydroxyl compound of the formula (II):



The only difference in both compounds is that formula (I) has a -CO- group where formula (II) has a -CH(OH)- group. In other words, the keto group of formula (I) has been converted to a hydroxyl group in formula (II). This transformation is well-known to persons skilled in the art as “reduction.” The Free Dictionary by Farlance at www.thefreedictionary.com/reduction defines “reduction” as, among other things, “A reaction in which hydrogen is combined with a compound.” This definition encompasses the change from formula (I) to formula (II) as hydrogen combines with the keto group of formula (I) to form the hydroxyl group in formula (II).

In short, the conversion from formula (I) to formula (II) as taught in the instant specification is expressly stated to be and would be understood by any person having ordinary skill in the art to be a “reduction” and, therefore, the action of “reducing.” The term “reduction” has *ipsis verbis* support in the instant specification, and, thus, provides support for “reducing,” but even if “reduction” did not appear in the specification, its use or the use of “reducing” instead would not constitute new matter. In this regard, Applicants point out that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added *word* is a word that is used in the application as filed, but whether the *concept* embodied by the added word is present in the original specification as filed. See, e.g., *In re Anderson*, 176 USPQ 331, 336 (CCPA 1973). As indicated above, persons skilled in the art would understand that the conversion from formula (I) to formula (II) involves “reduction” or “reducing” and, therefore,

the specification clearly conveys that concept to persons skilled in the art. Accordingly, the use of “reduction” or “reducing” in the claims cannot introduce new matter.

Claims 10-16 and 19-24 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the phrase “cell preparations” has no antecedent basis. In response, Applicants have deleted “cell preparations” from the instant claims without prejudice to claiming such subject matter in a later application.

Claims 10-16 and 19-23 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. According to the Examiner, there is inadequate enabling support for the term “microorganisms.” In response, Applicants have limited the term “microorganisms” to “*Saccharomyces cerevisiae* NG 247, *Saccharomyces cerevisiae* Y278 and *Geotrichum candidum* ATCC 34614,” which are supported by instant Examples 1-5. Again, Applicants reserve the right to prosecute the original scope in a later application if desired.

Claims 10-16 and 19-24 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. According to the Examiner, Applicants must make a deposit of microorganisms prior to issuance of the application as a patent. In response, Applicants submit that the strains recited in the claims are already accessible to the public and, therefore, a deposit is not necessary in this particular case. An early notice to that effect is earnestly solicited.

Claims 10-16 and 19-24 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, there is no written

description for all microorganism. In response, Applicants submit that this issue is moot in view of the amendments above.

Finally, claims 10-16 and 19-24 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. According to the Examiner, there is inadequate enablement for “cell preparations.” In response, Applicants submit that this issue also is moot in view of the amendments above.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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